

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 81-87 and 93-106 are pending. The Examiner has indicated that claims 83-85 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claim.

Applicants have been invited to make a showing under 37 CFR § 1.608(b). In response, Applicants state that they completed the invention prior to the effective filing date (i.e., May 1, 1992) of the application on which the US 5,498,392 patent issued. Submitted for the Examiner's consideration are declarations from one of the inventors, Prof. Richard M. White, and Mr. Scott A. Taper who corroborates the inventors' acts. Applicants completed conception of a device corresponding to the claims and due diligence was exercised until the device was reduced to practice. The invention was made in this country by Applicants prior to May 1, 1992. The declarations explain with particularity why Applicants are *prima facie* entitled to judgment that they are the first inventors. The declarations that are being submitted are not executed, but papers signed and dated by the declarants will be provided.

Evidence relied upon by declarants is being submitted as Northrup Exhibits A to Q. Dates prior to May 1, 1992 on the exhibits have been redacted. Those exhibits not discussed by Prof. White or Mr. Taper will be discussed by another declarant.

Declaration of an interference between this application and the US 5,498,392 patent of Wilding et al. is earnestly solicited.

In response to the objection that the title is not descriptive, a new title has been entered in accordance with the Examiner's suggestion.

35 U.S.C. § 112 – Written Description

The specification must convey with reasonable clarity to persons skilled in the art that applicant was in possession of the claimed invention as of the filing date sought. See *Vas-Cath v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The description includes "words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." *Lockwood v. American Airlines*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). But the Patent Office has the initial burden of presenting evi-

dence or a reason why persons of ordinary skill in the art would not have recognized such a description of the claimed invention in the original disclosure. See *In re Gos-teli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Claims 93-106 were rejected under Section 112, first paragraph, as allegedly "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." In particular, the Office Action questions whether a claim limitation describing a device comprised of chamber(s) and channel(s) of dissimilar dimensions is supported by the original disclosure. Applicants traverse because the drawings (e.g., Figure 2) show that the dimensions of the chamber(s) and channel(s) are dissimilar.

As noted on page 3 of the Office Action, claim 93 is directed to a device comprising a chamber and a channel of dissimilar dimension. It is not clear why this statement is followed by the allegation, "Instant claim 93, for example, includes devices with channels which either have the same dimension as the chambers or larger dimensions than the chambers." As previously noted on the same page, claim 93 recites the limitation "said chamber and said chamber being of dissimilar dimension." How can the Office Action allege that claim 93 adds new matter to the original disclosure? The "dissimilar dimension" limitation is supported by Figure 2.

It is instructive to compare the description in Wilding et al. (US 5,498,392) for the "dissimilar dimension" limitation which is recited in their issued claims. The limitation is not described in words by Wilding et al. Instead, they cited support for the amendment in the original drawings. See page 4 of Amendment (Paper No. 36) in the US 5,498,392 file wrapper. Those drawings, like those in this application, show a channel with a dimension smaller than that of a chamber of the device.

Applicants request withdrawal of this written description rejection made under Section 112, first paragraph, because this specification conveys to a person skilled in the art with reasonable clarity that Applicants were in possession of the claimed invention. Claims 93-106 do not add new matter to the original disclosure.

35 U.S.C. §§ 102 and 103 – Novelty and Nonobviousness

Claims 81-82, 87 and 93-106 were rejected under Section 102(e) as being allegedly clearly anticipated by Wilding et al. (US 5,498,392). Applicants traverse, *inter alia*, because the Wilding et al. reference is not prior art.

Claims 81-82, 86-87 and 93-106 were rejected under Section 103(a) as allegedly unpatentable over Wilding et al. taken in view of Hafeman et al. (Science 240: 1182, 1988). Applicants traverse, *inter alia*, because the Wilding et al. reference is not prior art.

As shown by the attached declarations and exhibits, the US 5,498,392 patent of Wilding et al. is not prior art because Applicants completed the invention in this country prior to the effective filing date of the application on which the Wilding et al. patent issued.


Applicants respectfully submit that the claim rejections made under Sections 102 and 103 should be withdrawn.

Conclusion

Having responded to all pending objections and rejections in Paper No. 23, Applicants urge that the interference should be declared. The Examiner is invited to contact the undersigned if any further information is needed.

Respectfully submitted,

Intellectual Property Group of
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APPENDIX
MARKED-UP VERSION TO SHOW CHANGES

IN THE TITLE:

The title is amended as follows.

MICROFABRICATED REACTOR, PROCESS FOR MANUFACTURING THE
REACTOR, AND METHOD OF AMPLIFICATION